

Notice of Allowability

Application No.

09/715,294

Examiner

Ashwin Mehta

Applicant(s)

YADAV, NARENDRA S.

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the papers filed 06 January 2006.
2. ☒ The allowed claim(s) is/are 39,43,81-84 and 87.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>attached</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

Examiner's Amendment

1. The objections to claims 42 and 86 are moot, in light of their cancellation.
2. The rejection of claims 39-41, 43, 70, 80, 81, 83, and 85 under 35 U.S.C. 103(a) is withdrawn, in light of the claim amendments or cancellations.
3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with S. Neil Feltham on March 09, 2006.

The application has been amended as follows:

In the claims:

In claim 39, in line 5, the recitation, "the having" was replaced with --having the--; and in line 15, the term, --common-- was inserted after "floral".

In claim 81, in line 14, the term, --common-- was inserted after "floral"; and in line 22, the recitation, "expressed at least" was replaced with, --active only--.

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In claim 83, in line 13, the term, --common-- was inserted after “floral”; in line 20, the recitation, “expressed at least” was replaced with, --active only--; and the last line, the term, “first” was replaced with --second--.

The abstract was amended as follows:

In line 2 of the abstract, the recitation, “or excision” was deleted. In line 8, the recitation, “or excised” was deleted.

In the specification, the sentence on page 1, line 5, was amended as follows:

This application is a continuation in part of USSN 09/442,021, filed November 17, 1999, now U.S. Patent No. 6,632,980.

The title has been changed to --METHODS FOR REGULATED EXPRESSION OF TRIATS IN PLANTS USING MULTIPLE SITE-SPECIFIC RECOMBINATION SYSTEMS--.

4. Claims 39, 43, 81-84, and 87 are allowed.

5. The following is an examiner’s statement of reasons for allowance: Applicants have developed a method to control transgene expression in plants, using combinations of two site-directed recombination systems. One of the recombinases would remove a stop or blocking fragment that lies between a second recombinase-encoding gene and its promoter. The two recombinases can be expressed at different points in plant development. The second

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recombinase can then remove a stop fragment located in between a transgene and its promoter. Expression of the recombinases or transgene(s) does not have to occur immediately upon removal of the stop fragment, but is controlled by the choice of the promoters. In this manner, a method was developed in which transgene expression is prevented in a first generation transgenic plant, but commences in the second generation. The prior art teaches that the versatility and high recombination frequency of site-specific recombination systems allow their use for a wide range of applications, that they allow transgenes to be maintained in an inactive state for any number of generations, that such characteristics may be advantageous when transgene expression may be detrimental to cell function (Odell et al., *Use of Site-specific Recombination Systems in Plants*, In Homologous Recombination and Gene Silencing in Plants, 1994, pages 219-270, Ed. Paszkowski, J., Publisher: Kluwer, Dordrecht, Germany). However, the prior art does not teach or fairly suggest the combination of constructs, specificity of promoters, and steps used to control the timing of transgene expression in the instantly claimed methods.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Contact Information

Any inquiry concerning this or earlier communications from the Examiner should be directed to Ashwin Mehta, whose telephone number is 571-272-0803. The Examiner can normally be reached from 8:00 A.M to 5:30 P.M. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached at 571-272-0975. The fax phone numbers for the organization where this application or proceeding is

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assigned are 571-273-8300. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

March 10, 2006



Ashwin D. Mehta, Ph.D.
Primary Examiner
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